

Application/Control Number 10/686,995
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REMARKS:

These remarks are in response to the final Office Action mailed August 1, 2006, in which claims 1-5 are pending. Claims 1-5 stand rejected.

In the present Amendment and Response, the Applicant has cancelled claim 1. The subject matter of claim 1 has been imported into claims 2 and 3, which are now both independent claims. In addition, the subject matter of claim 1 (when imported into claims 2 and 3) was amended to note that the “0.1% to about 5.00% of dichlorobenzyl alcohol” is “a topical agent for the prevention of bacteria growth on the skin during shaving.” This distinction is significant (see below). Support for the amendment can be found in the specification at least in paragraph [0006]. Accordingly, no new matter was added in making the above-described amendments.

The Applicants provide the following remarks in response to the Examiner’s rejections of the claims.

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,523,081 to Edwards (hereinafter “the ‘081 patent”) in view of U.S. Patent No. 5,985,299 to Buerger et al. (hereinafter “the ‘299 patent”)

In making the above rejection, the Examiner alleges that the ‘081 patent teaches all the limitations of claim 1 (now part of claims 2 and 3) except the use of dichlorobenzyl alcohol. The Examiner further alleges that the ‘299 reference teaches use of dichlorobenzyl alcohol at a concentration from 0-2%, more preferable from 0-1% and most preferably around 0.5% by weight (*i.e.*, as a pore cleaning formulation). The Examiner concludes that it would have been obvious for one of ordinary skill in the relevant art to combine the teachings of the ‘081 and ‘299 references and utilize dichlorobenzyl alcohol as the preservative. (See generally, the Office Action of August 1, 2006, pp. 2-4).

The Applicants disagree with the Examiner's position. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143.

Claims 2 and 3 both recite a shaving composition comprising from about 40% to about 90% by weight of water, from about 4% to about 25% by weight of water-soluble soap, from about 0.5% to about 12% by weight of an inert volatile liquid agent, and from 0.1% to about 5.00% of dichlorobenzyl alcohol, where the dichlorobenzyl alcohol is a topical agent for the prevention of bacteria growth on the skin during shaving. Claim 2 notes that the "volatile liquid agent comprises an aerosol propellant gas" and claim 3 recites that the "shaving composition further comprises from about 0.01% to about 5.00% by weight of water-soluble gelling agent."

The '081 reference is directed to a cosmetic composition for shaving products. The cosmetic composition is in aerosol or post-foaming gel form comprising water, soap, an inert volatile liquid agent, optionally a gelling agent, and a polyorganosiloxane micro-emulsion having an average particle size of less than 0.14 microns. The cosmetic composition comprises from 40-90% by weight of water, from 4-25% by weight of water-soluble soap, from 0.5-12% by weight of an inert volatile liquid agent and optionally from 0.0105% by weight of a water-soluble gelling agent. The composition further includes from 0.01-15% by weight polyorganosiloxane micro-emulsion.

The '299 reference pertains to a cosmetic pore cleaning product for treatment of skin including the removal of keratotic plugs from the pores of skin. The cosmetic pore cleaning products are comprised of formulations including non-ionic, film-forming, solvent-activatable polymers. The formulations include N-vinyl formamide as in poly (N-vinyl formamide). The 2% by weight, more preferable from 0.1.0% by weight and

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most preferably 0.5% by weight. The products are used to remove keratotic plugs by applying the product to the skin, allowing product to dry, and peeling the product from the skin.

Unlike claims 2 and 3 of the present application, the '299 reference does not teach or suggest a shaving composition comprising from 0.1% to about 5.00% dichlorobenzyl alcohol, where the dichlorobenzyl alcohol is a topical agent for the prevention of bacteria growth on the skin during shaving. Instead, the '299 reference describes the use of dichlorobenzyl alcohol for *stabilizing* the composition and/or preventing the growth of bacteria and/or molds therein. Furthermore, there is no motivation for one of skill in the art to supplement the '081 reference with the teachings of the '299 reference for the purpose of adding a dichlorobenzyl alcohol for the purpose of adding "a topical agent for the prevention of bacteria growth on the skin during shaving." The '299 reference, simply put, does not teach such a topical agent for such a purpose. Rather, the '299 reference teaches using a dichlorobenzyl alcohol for preventing growth of bacteria in a composition for *stabilization* purposes. That is a very different reason than adding a dichlorobenzyl alcohol for preventing growth on the skin during shaving. Accordingly, one of skill in the art would not look to the '299 reference to modify the '081 reference because there is simply no teaching, suggestion or motivation to combine.

Because there is no teaching, suggestion, or motivation to combine the '081 and '299 references, they are not properly combinable. Therefore, it is asserted that the cited prior art does not render the present inventions, as recited in amended claims 2 and 3, obvious. Favorable reconsideration of the rejection of claims 2 and 3 is requested.

Claims 4 and 5 depend from claim 3 and are therefore allowable over the cited prior art for at least the same reasons mentioned above, as well as by virtue of the additional recitations included therein. Favorable reconsideration of the rejection of these claims is also requested.

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Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '081 patent in view of U.S. Patent No. 5,523,017 to Moran et al. (hereinafter "the '017 patent")

In making the above rejection, the Examiner alleges that the '081 reference teaches all the limitations of claim 1 (now a part of claims 2 and 3) except the use of dichlorobenzyl alcohol. The Examiner further alleges that the '017 reference teaches use of dichlorobenzyl alcohol in solid cleansing bars including shaving bars at a concentration from 0.2% to 0.5%. The Examiner also alleges that the '017 reference teaches the addition of colors, fragrances, medicaments, astringents, deodorants, antidandruff substances, and antibacterial agents in the amount of 0.5-5%. The Examiner concludes that it would have been obvious for one of ordinary skill in the relevant art to combine the teachings of the '081 and '017 references and utilize dichlorobenzyl alcohol as the bactericide. (See generally, the Office Action of January 24, 2006, pp. 6-9).

The Applicants disagree with the Examiner's position. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143." And, when reviewing the prior art, each "...reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." See MPEP 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

The teachings of claims 2 and 3 are provided above.

The teachings of the '081 patent are also provided above.

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The '017 reference is directed to a *solid cleansing bar* for use as a shampoo, a skin cleaning bar or a shaving bar. The solid cleansing bar comprises a composition including from 70% to 80% by weight of a polyethylene glycol (PEG) base system having an average molecular weight between 6,500 and 8,500. The base system may comprise a mixture of PEG 6000, PEG 8000 and PEG 400. The composition includes from 12% to 20% by weight of a detergent which is typically a combination of an anionic surfactant and an amphoteric surfactant. The composition can also include up to 12% coactive ingredients such as foam stabilizers, pearlizing agents, emollients and conditioners. In addition the composition can include colors, fragrances, deodorants, and antibacterial agents generally in concentrations between 0.5 to 5%, including 0.2-0.5% dichlorobenzyl alcohol.

The accuracy and/or the consistency of the disclosure of the '017 patent is questionable. For example, in Example 9 ("the Skin Cleansing Bar", col. 4, line 55 – col. 7, line 42), which is the specific Example on which the Examiner bases the present rejection, it is explicitly recited that one of the advantages of the polyethylene glycol base system matrix is that...“(f) the system is...non-toxic to plant or animal life such as fish and bacteria.” (See the '017 patent, col. 5, lines 20-22). This appears to be in direct contradiction to the later statement that dichlorobenzyl alcohol is a potential coactive ingredient, since dichlorobenzyl alcohol *is* an antibacterial agent. Accordingly, one of skill in the art would not look to the '017 patent, a disclosure for a cleansing bar that purports to disclose a *non* anti-bacteria substance in order to attempt to modify '081 patent in order to create a shaving aid that *is* anti-bacterial during the shaving process. The Examiner is reminded that when reviewing the prior art, each "...reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." See MPEP 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

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Accordingly, the Applicants submit that it would not be obvious to one of skill in the art to look to the '017 patent to modify the '081 reference. In fact, in light of the statement that the solid bar of the '017 patent is non-toxic to bacteria, one of skill in the art would, in fact, look away. Therefore, because the '081 and '017 references are not properly combinable, it is asserted that the cited prior art does not render the present invention, as recited in amended claims 2 and 3, obvious. Favorable reconsideration of the rejection of claims 2 and 3 is requested.

Claims 4 and 5 depend from claim 3 and are therefore allowable over the cited prior art for at least the same reasons mentioned above, as well as by virtue of the additional recitations included therein. Favorable reconsideration of the rejection of these claims is also requested.

Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/06153 to Moldovanyi (hereinafter “the Moldovanyi reference”) in view of U.S. Patent No. 2,945,782 to Schraufstatter (hereinafter “the ‘782 patent”)

Claim 1 has been cancelled and its subject matter incorporated into claims 2 and 3 (now independent claims). Accordingly, this rejection has been rendered moot.

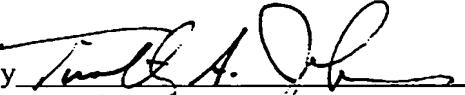
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Summary

The Applicants have addressed each of the Examiner's objections and traversed all of the rejections of the outstanding Office Action through the above remarks. In light of the above, it is respectfully requested that claims 2-5 be allowed to issue as a patent.

A check covering the fee for a Request for Continued Examination is included with the present Amendment and Response. No additional fees are believed to be due at this time; however, if any deficiencies do exist, please charge them to Account No. 503342, which is maintained by the Applicant's attorney. If the Examiner has any questions, please feel free to contact the Attorney of Record at the contact information provided below.

Respectfully submitted,

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